

combination is the claims of Group II and subcombination is the claims of Group I. To support a restriction between a combination/subcombination, two-way distinctness is required, which has not been shown in the present restriction requirement. Therefore, it is submitted that Groups I and II are not restrictable and must be examined together.

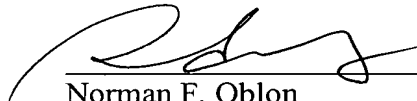
The Examiner characterizes the inventions of Groups I and III as process of making and product made and states that the product can be made by a different process, such as, CVD. The Examiner has not indicated how a CVD process might be used to form a hard film of Group I on a cutting tool and, therefore, it is submitted that Groups I and III are not restrictable and must be examined together. Further, the Examiner is requested to rejoin the claims of Groups I and III under M.P.E.P. §821.04, if a determination is subsequently made of allowability for the elected claims of Group I, Claims 1-9.

The Examiner characterizes the inventions of Groups III and IV as process and apparatus for its practice and states that the process can use a different target, such as, two targets having the combined claimed composition. However, it is clear that the process of Group III requires the hard film of Group I and the Examiner has not shown how a process using two targets would be able to produce the claimed hard film composition, particularly in light of the differences in rates of vaporization and deposition of various metals. Therefore, the inventions of Groups III and IV are not restrictable and must be examined together.

Accordingly, for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the restriction requirement and withdrawal of the restriction requirement is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Roland E. Martin
Registration No. 48,082



22850

TEL: (703) 413-3000
FAX: (703) 413-2220
I:\atty\rem\217474US-am.doc